



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/609,073

06/30/2000

CONNIE T MARSHALL

ODS-9

2964

75563 7590 12/08/2008

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/609,073
Filing Date: June 30, 2000
Appellant(s): MARSHALL ET AL.

James Leiz, Brian Mack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/25/2007 appealing from the Office action mailed 1/29/2007.

PRELIMINARY REMARKS

After further consideration, this application contains at least one claim that does not meet the patent eligibility requirement for statutory subject matter under 35 USC 101. Accordingly, this examiner's answer contains a new ground of rejection under 35 U.S.C. 101. Appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to

Art Unit: 3714

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the amended section submitted 12/1/2008 is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- Appellant has stated that claims 2-9, 11-19, and 38-48 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,830,068 Brenner (see pages 4-5 of the Brief). In a footnote on page 4 of the Brief,

Appellant acknowledges that the rejection listed in the Office Action mailed 1/29/2007 was actually under 35 U.S.C. 102(e) but, for reasons unknown, believes that the rejection should have been made under 102(a). The Examiner submits that the rejection under 102(e) is correct and it constitutes the prior art grounds of rejection to be reviewed on appeal for claims 2-9, 11-19, and 38-48.

- A rejection was made under 35 U.S.C. 112, first paragraph regarding the scope of enablement for claims 11, 14, 15, 38, 43, and 44 (and claims 13 and 39-42 which depend therefrom). In light of Appellants' persuasive explanations on pages 15-17 of the Brief, the rejection under 35 U.S.C. 112, first paragraph is hereby withdrawn. Note: the rejection is omitted from Section (9) below since it is no longer relevant.

NEW GROUND(S) OF REJECTION

- Claims 2-11 and 14-19 are rejected under 35 USC §101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). A full explanation of this new ground of rejection is presented below in Section (9).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct. Note that the claims are contained in section (viii) of the Appeal Brief (also called Claims Appendix A).

(8) Evidence Relied Upon

5,830,068	Brenner et al.	11-1998
6,004,211	Brenner et al.	12-1999

Sanna, Paul et al. "Special Edition Using Windows NT Workstation 4.0", Que Corporation, 1997, Accessed via ProQuest on 17 Aug. 2007, pp. 1-14, submitted with author and copyright pages. (A copy of the reference is attached to the Examiner's Answer mailed 8/22/2007.)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Interpretation

Claim 19 is directed in pertinent part toward 1) allowing a user to create and place a wager for a given race; 2) automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race; and 3) recording the given race. The term "opportunity" is defined as a situation or condition favorable for attainment of a goal (Random House Unabridged Dictionary). Therefore, automatically providing an opportunity to record a race in response to placing a wager, as stated in (2) above, is interpreted as automatically (*without additional effort*) providing an opportunity (*favorable situation or condition*) to record a race in response to (*after*)

Art Unit: 3714

placing a wager. An analogous interpretation is applied to claim 48. As described below, such features are anticipated by the prior art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-7, 11-19, 38, and 39-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 17, 37-41, 46 and 49 of U.S. Patent No. 6,004,211 to Brenner et al. (hereinafter Brenner ‘211). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Brenner ‘211 fully encompass the instant claims, as shown in view of the interpretation set forth above.

Claim 39 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of Brenner ‘211. Brenner ‘211 teaches a

Art Unit: 3714

user terminal configured to perform the functions necessary for operation (e.g. the user terminal contains the “control circuitry” as described in instant claim 39). Brenner ‘211 lacks describing that the user terminal is a set-top box. A set-top box, as described in the context of the claims, is merely a device dimensioned to be capable of sitting on top of a monitor. Such a limitation changes the size of the device, but does not affect the way in which the device operates. As such, instant claim 39 is not patentably from claim 37 of Brenner ‘211. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (The Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.) Therefore, it would have been an obvious matter of choice, well within the capabilities of one of ordinary skill in the art at the time of invention to embody the control circuitry of Brenner ‘211 in a set-top box in order to minimize the size of the device so as to allow the device to sit atop a monitor (the monitor being required by Brenner ‘211 to operate).

Claims 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 5 of Brenner ‘211. Claims 1, 4, and 5 of Brenner ‘211 allow, in pertinent part, a user to select and view video clips of particular races using a user terminal. Brenner ‘211 lacks in describing that the recorded races are listed with corresponding track names, race numbers, or dates. However, it is clear from the claims of Brenner ‘211 that a user must be able to discern

Art Unit: 3714

an individual race from a plurality of previously recorded races and input a request to view said race. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to list recorded races with their corresponding track names, race numbers, and/or dates in order to allow a user of the system to identify and select a particular race as is required by the claimed system of Brenner '211.

Claim Rejections - 35 USC § 101

New Grounds of Rejection

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-11 and 14-19 (and claims dependent thereon) are rejected under 35 U.S.C. 101 because they are directed toward non-statutory subject matter. This is a new ground of rejection.

Claims 2-11 and 14-19 are method claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending).

Claim 19 is directed toward a method for interactively wagering on races with an interactive wagering application implemented using user equipment. However, this does not represent a substantial tie to another statutory class at least because the

Art Unit: 3714

recitation of “user equipment” appears only in the preamble of the claim. Based upon rationale set forth by the above court cases, recitations in the preamble of a claim are not adequate to establish a substantial tie. As such, even if a dependent claim further defines the particular user equipment (such as claim 11 defining the user equipment as “user television equipment”), the dependent claim would merely limit recitations only found in the preamble of independent claim 19. By contrast, claims 12 and 13 further define the method set forth in claim 19 by establishing that a given race is recorded with a videocassette recorder (claim 12) or a digital video recorder (claim 13). Furthermore, claims 2-11 and 14-19 do not transform any underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 3714

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2-9, 11-19, and 38-48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 5,830,068 to Brenner et al. (hereinafter Brenner '068).

Regarding claims 19 and 48, Brenner '068 teaches a method and system for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment (see at least abstract, figs. 1, 2, 29, 30, and cols. 2-5). Brenner '068 further teaches a system and method step of allowing the user to create and place a wager for a given race (see at least abstract, figs. 3-7, 15, 31-34, 36-44, 46, 48-50, and cols. 2-5). Brenner '068 additionally teaches a system and method step of recording the given race (see at least figs. 30, 34, 49 and cols. 3:11-14, 4:65-5:3, and 27:65-28:15).

Further regarding claims 19 and 48, Brenner '068 teaches a system and method step of automatically providing the user with an opportunity to record the wagered upon race in response to the user placing the wager for the given race. Figure 31 shows a flow chart for placing a wager on a particular race, with figures 36-39 showing user interfaces for placing the wager. Box 486 of figure 31 shows the "Place Wager" selection, which instructs the system to Place Wager operation 510, and then returns to box 486. Therefore, Brenner '068 teaches a system and method step of allowing a user to create a wager for a given race. Box 486 is represented by the user interface of figure 39. The flow charts of figures 31, 32, and 34 (explained in cols. 23-28) and the user interfaces of figures 48-49 show that in response to placing the wager, the user

Art Unit: 3714

automatically has the *opportunity* to record the wagered upon race by selecting menu choices “Other Race” and “Tape/VCR” to program a video recorder to record the race (see at least cols. 27:65-28:15). Therefore, in Brenner ‘068 the opportunity to record the race is provided automatically and in response to placing a wager.

Regarding claims 2 and 3, Brenner ‘068 states, “If ‘tape/VCR’ is selected at step 596 (FIG. 34), at step 606 (FIG. 34) user terminal 370 (FIG. 30) programs video recorder 424 (FIG. 30) with the appropriate recording information or actuates video recorder 424 (FIG. 30) at the time of the selected race. Thus, selecting ‘tape/VCR’ allows the selected race to be recorded” (col. 28:5-11). Therefore, selecting “yes” is anticipated by a user of Brenner ‘068 pressing “Tape/VCR” to actuate recording, whereas selecting “no” is anticipated by a user of Brenner ‘068 pressing any other button and/or not pressing “Tape/VCR”.

Regarding claims 11, 38, and 40, Brenner ‘068 teaches that the user equipment is user television equipment, for example in the form of a “conventional television monitor” (col. 3:59-60).

Regarding claims 12 and 41, Brenner ‘068 teaches that a recording device may be a “conventional video cassette recorder” (col. 21:56-58).

Regarding claims 13 and 42, Brenner ‘068 teaches recording a given race with a digital video recorder indicated by the digitally-compressed video signals being processed, encoded, decoded, and transmitted by the video and data distribution system 368 and/or the user terminal 370 (see at least 27:46-64). The digital video

Art Unit: 3714

recorder is further indicated by the recitation of a high capacity storage medium, suitable for recording races as they are received from racing video source 374, embodied in video and data distribution system 368 (see at least 27:39-45).

Regarding claims 14 and 43, Brenner '068 describes employing user computer equipment in the form of user terminal 122, which is described as being "preferably microprocessor-based [and] supports software capable of coordinating the receipt and display of racing data and the placing of wagers electronically" (col. 7:21-24). See also fig. 1 and col. 7:24-34.

Regarding claims 15 and 44, Brenner '068 teaches that user equipment is telephone equipment used to implement the interactive wagering application (see at least 7:35-54, 8:29-40).

Regarding claim 16, Brenner '068 teaches recording a race in real-time (see at least col. 6:55-62 and 17:65-18:40).

Regarding claims 17 and 47, Brenner '068 describes recording the race after it has taken place (see at least cols. 26:65-27:22).

Regarding claim 18, Brenner '068 teaches charging a fee for recording a given race (see at least col. 27:33-39).

Regarding claim 39, Brenner '068 discloses using a set-top box 434 disposed between display and processing circuitry 416 and monitor 378 (see at least fig. 30 and 22:13-15). Therefore, Brenner '068 teaches a set-top box wherein control circuitry is

Art Unit: 3714

located, wherein the control circuitry is configured to allow the user to create and place a wager for a given race.

Regarding claims 6 and 45, Brenner '068 teaches a recording device located remote from the user equipment (see at least 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29).

Regarding claims 4, 5, 7, and 46, as described above, Brenner '068 teaches recording racing videos on a videocassette, which is interpreted as a personal archive. Further support for the interpretation is found in above-cited sections of Brenner '068 regarding the user's own home equipment (e.g. the video cassette recorder), which is personal equipment and personal recording media (e.g. the video cassette). Brenner'068 further describes using the interactive wagering application to allow the user to access the personal archive at the head end or at the user equipment and view previously recorded races in cols. 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29. See also local mass storage device 578 (FIG. 3).

Regarding claims 8-9, Brenner '068 teaches listing previously recorded races in the personal archive with their corresponding track name and race number (see at least figs. 49-50 and descriptions thereof).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3714

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner

'068. Brenner '068 teaches the interactive wagering system substantially as described above. Brenner '068 lacks in specifically disclosing that previously recorded races in the personal archive are listed with their corresponding date. As described in Brenner '068, players place wagers on specific races, which requires that the player be able to correctly identify the results of a given race, for example in order to select from a list a previously recorded race upon which a player has placed a wager. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide date information with previously recorded races in order to allow users to correctly identify when the race took place. See at least figs. 49-50 and descriptions thereof.

(10) Response to Argument

Section A

Beginning on page five, Appellants argue that 'reopening prosecution is improper and unduly delays the issuance of the patent'. The Examiner notes that this is not an appealable issue and the argument is therefore moot. However, because Appellants seem to be confused about the grounds of rejection applied to their claims, the Examiner will briefly reply. The grounds of rejection stated in section (9) above are, in fact, the grounds of rejection that should be considered on appeal. Any previous grounds of rejection in previous Office Actions are or were withdrawn. Appellants need not refer to grounds of rejection other than those listed hereinabove.

In their confusion, Appellants attempted to provide a copy of the Appeal Brief dated July 19, 2006 in Evidence Appendix C. The Examiner notes that no additional copy of the July 19 Appeal Brief appears to have been submitted. However, it should make no difference to this Appeal Brief, since the July 19 Appeal Brief addressed rejections that have been withdrawn.

The (current) Appeal Brief states on page 6, "Appellants want to exercise their statutory right to have their application reviewed by the Board without any further undue delay." The Examiner is unaware of any statute that bars the Examiner from reopening prosecution on an application when new grounds of rejection are applied and supervisory approval to reopen prosecution is obtained. In any case, this is not an appealable issue and the argument is moot.

On page 7 of the Brief, Appellants state that the Examiner believes that the previous 103 (a) rejection is still a proper rejection of the claims. This is incorrect. As stated above, all rejections prior to reopening prosecution were withdrawn and replaced by those listed in the Office Action mailed 1/29/2007 or as listed above.

Section B

Appellants attempt to traverse the prior art rejection of Brenner '068. Note that the rejection is made under 102(e) and not 102(a), as was described hereinabove.

In subsection (i) Appellants describe their central argument (see pages 7-10 of the Brief). Appellants essentially argue that automatically providing a user with an opportunity to record a given race in response to placing a wager on the given race is a patentable difference over the cited prior art. The Examiner respectfully disagrees.

The Examiner submits that given the broadest reasonable interpretation of the claimed subject matter, Brenner '068 anticipates Appellants' independent claims. For example, claims 19 and 48 are directed in pertinent part toward allowing a user to create and place a wager for a given race, automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race, and recording the given race. As was explained in the Office Action dated 1/29/2007, the term opportunity is interpreted as "a situation or condition favorable for attainment of a goal," in accordance with the definition from a common language dictionary (see *Claim Interpretation* above). Appellants have never challenged this dictionary definition and the Examiner submits that it is proper regardless.

Claims 19 and 48 do not state that the given race upon which a wager is made is automatically recorded, but rather claims 19 and 48 state that there is an opportunity to record the race and the opportunity is automatic. Therefore, when the claim language is directed toward automatically providing an opportunity to record a race in response to placing a wager, as recited in the independent claims, it is interpreted by the Examiner as automatically (*without additional effort*) providing an opportunity (*favorable situation or condition*) to record a race in response to (*after*) placing a wager. As described in the grounds of rejection, such features are anticipated by the prior art.

As pointed out by the Examiner and repeated by Appellants on e.g., pages 8-9, Brenner '068 teaches that a user of his system is permitted to select the menu options in order to instruct the device to record a race. Detailed citations of Brenner '068 are given above in the grounds of rejection and will not be repeated herein. Essentially,

Art Unit: 3714

Appellants are arguing that because the user must push a few buttons (e.g., the player selecting “Other Races” or “Tape/VCR”) in between placing his wager and choosing to record the given race, Brenner ‘068 fails to automatically provide an opportunity to record the race. This simply is not true. Clearly the user is given the opportunity to select to record the wagered-upon race, despite the fact that he must push buttons in order to do it. The claims do not say that the race is automatically recorded in response to the wager being place, but rather that there is an *opportunity* to record the race, the *opportunity* being automatic. The conditions for a player to record the race, or opportunity to record the race, are present in response to placing the bet and are automatic. Therefore, Brenner ‘068 anticipates the independent claims.

In subsection (ii) Appellants attempt to show patentability of dependent claim 2 (see pages 10-11 of the Brief). The Examiner submits that nowhere in claim 2 is there any indication that the words “yes” or “no” are displayed on a screen of the claimed invention, contrary to Appellants’ apparent assertion. The Examiner interprets the claim 2 as allowing the user of Appellants’ system to enter a command into the system to accept or decline the option of recording the given race. When one considers the teachings of Brenner ‘068 and what a player must do in order to record a race (as detailed in the grounds of rejection above), it is clear that the player has the option to either record the given race or not record the given race. Therefore, the rejection of claim 2 should be sustained. The Examiner notes that even if there were some indication that “yes” or “no” are displayed to the player (which is clearly not the case), there is absolutely no criticality to using this exact verbiage. Clearly one could just as

Art Unit: 3714

easily use synonyms of “yes” or “no” to produce exactly the same results, meaning that even if Appellants correctly characterized claim 2 (which they have not), claim 2 would still fail to show a patentable difference over the cited prior art.

In subsection (iii) Appellants attempt to show patentability of dependent claim 8 (see pages 11-12 of the Brief). Appellants argue that Brenner ‘068 does not teach listing previously recorded races in the personal archive with their corresponding track name and race number, rebuffing the Examiner’s reference to figures 49 and 50 (and corresponding disclosure) of Brenner ‘068. The Examiner submits that even a cursory review of figures 49 and 50 show previously recorded races with their corresponding track name and race number. For example, Races 1-4 are shown under the heading “Select Race”. These are examples of “race numbers” as recited in claim 8, wherein races 1 and 2 are previously recorded as evidenced by the fact that the player may choose to see the outcome of those races. Furthermore, the track name “Hollywood Park” is shown by figure 49 in the top left hand corner. Similarly, figure 50 shows “Hollywood Park” track name and “Race 1” race number, and additionally presents the user the option of watching the race.

Appellants appear to believe that the above features do not refer to a “personal archive” because the above figures “enable users to set a recording or order a video of a race” (page 12 of the Brief). The Examiner submits that figures 49-50 and their respective features clearly show a personal archive at least because they allow the user to 1) set his own recording of an upcoming race or 2) allow the user to make a personal, individual order to view a previous race on demand. This is in contrast to e.g., watching

Art Unit: 3714

conventional television programming over which the user has no control over the content of a particular channel. Therefore, the rejection of claim 8 should be sustained.

Section C

Beginning on page 12 of the Brief, Appellants challenge the rejection of claim 10 under 35 U.S.C. 103(a). As described in the grounds of rejection above, Brenner '068 teaches that players place wagers on specific races, which requires that the player be able to correctly identify the results of a specific race. Further taught by Brenner '068 is the fact that players select from a list of previously recorded races for the purpose of viewing those races. Those race videos may portray the results of one or more races upon which a player has placed a wager, which demonstrates a clear benefit to displaying to the user the date on which a race took place. It is clear that the device of Brenner '068 is capable of and intended for use over more than a single day. Therefore, because a user of Brenner '068 must be able to identify the individual races, potentially over a plurality of days, there is clearly a need to display the date on which races took place. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide date information with previously recorded races in order to allow users to correctly identify when the race took place. The rejection of claim 10 under 35 U.S.C. 103(a) should be sustained for at least these reasons.

It should be noted that Brenner '068 demonstrates displaying date and time information in figure 8, element 178. This serves as further proof that Brenner '068 contemplates associating and displaying date and time information in relation to betting on and viewing races.

Additionally, because the video of Brenner '068 may be stored in digital format, it is inherent that the date of a recording is stored in association with the digital data (see e.g., col. 27, lines 39-45). The Examiner submits that virtually every modern computer operating system appends a date to digital files representing the date that the file was created. As an illustrative example, Windows NT employed a file system that identified the date and time that each file was created (see page 9 of *Special Edition Using Windows NT Workstation 4.0*). The figure on page 9 demonstrates that a file's creation date is available to the user at the click of the mouse. This is yet another exemplary showing that recording and displaying to a user, the date of a race video (or any other file type) was well within the capabilities of one of ordinary skill in the art at the time of Appellants' invention. Appellants' claim 10 is nothing more than a combination of prior art elements according to known methods to yield predictable results. For at least these reasons, rejection of claim 10 under 35 U.S.C. 103(a) should be sustained.

Finally, claim 10 was also rejected over Brenner '211 based upon non-statutory obviousness type double patenting (see Grounds of Rejection above and Section D below). The double patenting rejection is based on similar logic to that of the 103 rejection detailed above. Specifically, the Examiner stated that it is clear from the claims of Brenner '211 that a user must be able to discern an individual race from a plurality of previously recorded races and input a request to view said race. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to list recorded races with their corresponding track names, race numbers, and/or dates in order to allow a user of the system to identify and select a particular race as is required

Art Unit: 3714

by the claimed system of Brenner '211. Appellants' have made no argument challenging the specific logic behind the obviousness-type double patenting rejection. Since this logic is substantially similar to that of the 103 rejection, the Examiner submits that the rejection of claim 10 under 35 U.S.C. 103(a) should be sustained.

Section D

Beginning on page 13 of the Brief, Appellants challenge the double patenting rejection of claims 2-19 and 38-48 over Brenner '211. As an initial matter, it should be noted that Brenner '211 is a continuation of Brenner '068, meaning that each of the Brenner patents share the same specification. Therefore, the Examiner respectfully submits that if the obviousness-type double patenting rejection over Brenner '211 (and teachings from other prior art) is sustained, then the prior art rejection of Brenner '068 (and the teachings from the same prior art) above must also be sustained because the claims of Brenner '211 are enabled by the same specification as Brenner '068.

On page 13 of the Brief, Appellants accuse the Examiner of ignoring the citations in case law proffered by Appellants in previous communications with the Office. Those citations allegedly dictate that obviousness-type double patenting (ODP) rejections should be used for references that are not available as prior art under 35 U.S.C. 102 or 103. The Examiner respectfully disagrees. The purpose of an ODP rejection is to prevent improper or unjustified timewise extension of the right to exclude. MPEP 804 states the following:

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re

Art Unit: 3714

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

The Examiner has pointed to Chart II-B listed in MPEP 804.03 to show, in graphical format, that ODP rejections are proper in situations such as this. Appellants have acknowledged the charts, but consistently dismiss the charts of the MPEP, calling them “preliminary instances where the Examiner cannot resolve the ownership of the application and the ownership of the reference with conflicting claims” (Brief, page 14). The Examiner respectfully submits that whether the invention shared a common assignee with Brenner ‘211 at the time of invention is irrelevant because the two are commonly assigned now and an ODP rejection is proper either way. Both situations are shown on the lowest two branches of Chart II-B and both situations allow for an ODP rejection. Therefore, the ODP rejection over Brenner ‘211 should be sustained.

The Examiner acknowledges that Chart II-B gives a footnote in the situation where inventions are from different inventive entities, commonly owned at the time of invention (second branch from the bottom of the chart). The box representing this situation instructs the Examiner to make an ODP rejection. The footnote instructs the Examiner that where the reference is available as anticipatory prior art, a rejection should be made under 102(e). The Examiner believes this note is intended to produce the “strongest” grounds of rejection by citing a 102(e) rejection in conjunction with an ODP rejection. However, because Brenner ‘068 is the parent of Brenner ‘211, it is

Art Unit: 3714

appropriate to use Brenner '068 for the 102(e) rejection (see above) instead of Brenner '211. An additional 102(e) rejection over Brenner '211, while technically proper, would be redundant since there is already a 102(e) rejection using Brenner '068.

Appellants have repeatedly cited a portion of the MPEP that instructs the Examiner on the manner of making an ODP rejection. That citation states “[a] double patenting rejection of the obviousness-type...is ‘analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103’ except that the patent principally underlying the double patenting rejection is not considered prior art”. See MPEP 804 (B)(1). Appellants base their argument upon the last few words of the citation: “the patent principally underlying the rejection is not considered prior art”. The Examiner believes that this refers to the fact that the underlying patent in a double patenting rejection (in this case, Brenner '211) must be considered in terms of its claims alone, as opposed to a prior art rejection that may be based upon teachings from anywhere in an underlying patent.

In view of the above arguments, the ODP rejection over Brenner '211 should be sustained.

Section E

Section E refers to a rejection under 35 U.S.C. 112, first paragraph regarding the scope of enablement for claims 11, 14, 15, 38, 43, and 44 (and claims 13 and 39-42 which depend therefrom). In light of Appellants' persuasive explanations on pages 15-17 of the Brief, the rejection under 112 (1) is hereby withdrawn.

Art Unit: 3714

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William H. McCulloch, Jr./
Examiner, Art Unit 3714

Conferees:

/Tom Hughes/
TQAS, TC 3700

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

/Robert P Olszewski/
Director, Technology Center 3700